

REMARKS

Issue is respectfully taken with the unsupported and unsupportable allegation that claim 21 is “directed to an invention that is independent or distinct from the invention originally claimed”. Any patentable invention must include both a method of making and a method of using any claimed product. Not only is claim 21 directed to a method of manufacturing the product of claim 1, it is dependent from and thus has all the limitations of claim 1. As stated in the opinion for *In re Kuehl*, 177 U.S.P.Q.250 (CCPA 1973), at 256:

The constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112 all aspects of what they regard as their inventions, regardless of the number of statutory classes involved.

Reconsideration of the withdrawal of claim 21, and action on the merits with regard to that claim are thus in order and are respectfully solicited.

The rejection of claims 1 to 11, 13 to 16 and 18 to 20 “under 35 U.S.C. 103(a) as being unpatentable over Spurgat in view of Chodha et al. (5985970)” is respectfully traversed. Chodha’s compositions include zinc oxide, as indicated in his Table 1. The tack-neutral additives, including metal oxides, are essential components in Chodha’s EPDM rubber compositions.

In contrast with Applicant’s purpose of using a rubber material free from metal oxide or sulfur, Chodha’s EPDM rubber compositions are equivalent to an EPDM prepared by using a curing agent containing metal oxide. Thus, Chodha cannot suggest the exclusion of metal oxide.

Applicant’s rubber material is free from metal oxide or sulfur as a curing agent or as additive. The amendment to Applicant’s claim 1 finds antecedent support, e.g., on page 4 of the specification, starting at line 7:

No sulfur or metal ion causing the pollution of the fuel-cell catalyst is dissolved from the rubber layer...

Also, reference is made to the second complete paragraph on page 5 of the specification.

Please note that Chodha does not suggest “the use of a rubber material for the innermost layer” in order to solve a specific problem in the hose for conveying a hydrogen fuel, as in the present invention, and does not give any motivation to attain the idea of the instantly claimed subject matter.

Chodha actually teaches the inclusion, rather than exclusion, of zinc oxide.

Neither Chodha nor Spurgat is concerned with or addresses the very problem faced and solved by Applicant's claimed invention. Neither would be consulted to solve the very problem to which Applicant's claims are directed.

As each ground of rejection is based on a combination of references. Attention is drawn to the opinion for *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed.Cir. 2002). Nothing is found in either of these references that would lead any artisan to combine any specific teachings of one with any specific teachings of the other. The applied combination is based on nothing more than Applicant's own teachings rather than direction extractable from the art itself.

Issue is also respectfully taken with any alleged inherency which is not established on the record. There is certainly no inherency whatsoever with regard to eliminating zinc oxide from Chodha's compositions.

The rejection of claim 12 "under 35 U.S.C. 103(a) as being unpatentable over Spurgat and Chodha et al. in view of Kitami et al. (4881576)" is also respectfully traversed. Please note that claim 12 is dependent from and thus has all the limitations of parent claim 1, and Kitami does not in any way overcome the previously noted deficiencies of the other two references. It is particularly noteworthy that Kitami's inner most layer (21) is described in a fashion in column 2 (starting at line 25) which appears to exclude EPDM. This would teach away from the propriety of any combination thereof which Chodha which is directed exclusively to EPDM compositions.

Having overcome all outstanding grounds of rejection, action on the merits with regard to claim 21, and allowance of all of Applicant's claims are in order and are respectfully solicited.

Respectfully submitted,

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